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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/789,004

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Samuel A. Vona JR.

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AKZO NOBEL INC.  
LEGAL & IP  
120 WHITE PLAINS ROAD, SUITE 300  
TARRYTOWN, NY 10591

EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

07/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/789,004  | <b>Applicant(s)</b><br>VONA, SAMUEL A. |  |
|                              | <b>Examiner</b><br>MELISSA S. MERCIER | <b>Art Unit</b><br>1615                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 and 20-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-26-09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Summary***

Receipt of Applicants Remarks and Amended Claims filed on April 8, 2009 is acknowledged. Claims 1-17 and 19 are cancelled. Claims 18 and 20-35 are pending in this application.

### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statement filed on March 26, 2009 is acknowledged. A signed copy is attached to this office action.

### ***Withdrawn Rejections/Objections***

#### ***Claim Objections***

The objection to claim 21 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn in view of Applicants Amendments to the claim.

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 18 and 20-29 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in view of Applicants amendment to the claims to recite "improving the color durability and stability of artificial color on hair".

***Claim Rejections - 35 USC § 102***

The rejection of claims 18, 20-22, and 24-29 under 35 U.S.C. 102(b) as being anticipated by National Starch and Chemical Corp (GB 1,285,547) has been withdrawn in view of Applicants persuasive arguments regarding the lack of a teaching of application to artificially colored hair.

The rejection of claims 18, 20-21, 23-25, and 28-29 under 35 U.S.C. 102(b) as being anticipated by Paul et al. (US 6,344,183) has been withdrawn in view of Applicants persuasive arguments regarding the lack of a teaching of application to artificially colored hair.

***Newly Applied Rejection***

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18, 20-22, and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over National Starch and Chemical Corp (GB 1,285,547) in view of Syed et al. (EP 0 829 255).

GB'547 discloses a hair setting composition comprising pregelatinized cationic high amylose containing starch (title, page 3, lines 85-91). The application of the composition to wet or dampened hair provides a film which can impart desirable properties such as body and smoothness (page 1, lines 16-28). The amylose content is

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more than 50% by weight of the starch (page 1, lines 51-52). The high amylose starch is present in the amount of 1-6% by weight of the total composition (page 1, lines 47-49).

It is additionally disclosed the composition can be utilized as a crème rinse which is applied after the users hair is washed and serves to effectively balance or neutralize the inherent negative charge of the hair (page 2, lines 20-35).

The amylose may be from corn (page 2, lines 36-40). Other film forming ingredients may be added (page 2, lines 65-69).

GB'547 does not disclose applying the composition to artificially colored hair.

Syed discloses a hair protection composition and process for preserving chemically process hair during subsequent processing's by applying a composition comprising a starch hydrolysate (abstract). Chemical processes include dyes and bleaching (page 2, lines 15-16), which reads on Applicants artificially colored hair in the instant claims. Syed discloses repeated coloring and bleaching cause structural damage to the hair and suffer the disadvantage of causing excessive damage to hair fibers (page 2, lines 57-58). Syed further discloses film forming polymers such as polypolyquaterniums (page 5, lines 32-35).

Since it is well known, as disclosed by Syed, the color treatment of hair causes damage, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the amylose as disclosed by GB'547 since it is taught that the amylose provides a protective property to the hair, such as smoothness and body. Since the prior art discloses the same patient population, (i.e. those with color treated hair), application of the product to perform a moisturizing

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property, would also necessarily also perform the same functional property of providing durability and stability to the hair color. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer."

*Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)

Claims 18, 20-21, 23-25, and 28-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (US 6,344,183) in view of in view of Syed et al. (EP 0 829 255).

Paul discloses a hair cosmetic composition comprising nonionically derivatized starches (abstract). The starch is present from 0.5-15% of the composition (column 2, lines 36-38). Suitable starches include high amylose corn starch (column 3, lines 40-44). High amylose is at least about 45% by weight amylose (column 3, lines 47-49), which would reasonably read on claim 20's "about 50% by weight". Film forming agents can be included (column 1, lines 46-47). The formulation may be in the form of lotions and creams (column 8, lines 1-2 and 45-48).

Paul does not disclose applying the composition to artificially colored hair.

Syed discloses a hair protection composition and process for preserving chemically process hair during subsequent processing's by applying a composition

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comprising a starch hydrolysate (abstract). Chemical processes include dyes and bleaching (page 2, lines 15-16), which reads on Applicants artificially colored hair in the instant claims. Syed discloses repeated coloring and bleaching cause structural damage to the hair and suffer the disadvantage of causing excessive damage to hair fibers (page 2, lines 57-58). Syed further discloses film forming polymers such as polypolyquaterniums (page 5, lines 32-35).

Since it is well known, as disclosed by Syed, the color treatment of hair causes damage, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the amylose as disclosed by Paul since it is taught that the amylose provides a protective property to the hair, such as smoothness and body. Since the prior art discloses the same patient population, (i.e. those with color treated hair), application of the product to perform a moisturizing property, would also necessarily also perform the same functional property of providing durability and stability to the hair color. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)

***Conclusion***

No claims are allowed. **Due to the new grounds of rejection presented in this office action, this action is made Non-Final.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615